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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/585,681

07/10/2006

Udi Chatow

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HEWLETT-PACKARD COMPANY

Intellectual Property Administration

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EXAMINER

BURNEY, RACHEL L

ART UNIT

PAPER NUMBER

1795

NOTIFICATION DATE

DELIVERY MODE

07/21/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/585,681	<b>Applicant(s)</b> CHATOW ET AL.	
	<b>Examiner</b> Rachel L. Burney	<b>Art Unit</b> 1795	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 03 May 2010.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,8-12,17-26,28-32,38 and 40-49 is/are pending in the application.
- 4a) Of the above claim(s) 18-24,28-32,34-36,38,40 and 41 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,8-12,17 and 42-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 July 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)         | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Objections***

1. Claim 45 is objected to because of the following informalities: the claim states “the average diameter of the additive particles make up between 5% and 10% by weight of toner particles”. The average diameter can not make up any part by weight of a toner particle. The examiner has interpreted the claim to mean “the additive particles make up between 5% and 10% by weight of toner particles” which is consistent with PP 0020 of US 2007/0105034 (PGPub of the instant application). Appropriate correction is required.

2. Claim 45 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 45 depends on claim 1. Independent claim 1 requires the additive particles to be present in "at least 10% by weight" the range 5% to 10%, as stated in claim 45, is outside the claimed range of the independent claim.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 8-11, 17, 45, 48, and 49 are rejected under 35 U.S.C. 102(e) as being anticipated by US PGPub 2004/0115550 (Sugiura).

Sugiura discloses a developer comprising a toner particles and a carrier liquid (PP 0198). The toner may comprise thermoplastic resin particulates (P 0139). The toner may comprise a polyethylene wax (PP 0130) in an amount of 1-40% by weight (PP 0131), and may further comprise a polymethylmethacrylate particle (PP 0146). The toner may comprise different resins (PP 0038), and the two resins may have different properties (PP 0047).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 12, 46 and 47 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over US PGPub 2004/0115550 (Sugiura).

Sugiura teaches that a thermoplastic resin is used, but fails to teach the melt flow index of the resin. When the reference discloses all the limitations of a claim except a property or function, and the examiner cannot determine whether or not the reference inherently possesses properties which anticipate or render obvious the claimed invention but has basis for shifting the burden of proof to applicant as in *In re Fitzgerald*, 619 F.2d 67, 205 USPQ 594 (CCPA 1980). See MPEP § § 2112- 2112.02.

Sugiura also fails to teach that the resin solvates and is plasticized by the carrier liquid, however because the resin is similar, and the carrier liquid is similar, it would be reasonable to conclude that the two would react in a similar fashion.

7. Claims 42-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over US PGPub 2004/0115550 (Sugiura) as applied to claim 1 above, and further in view of US Patent 6210852 (Nakamura).

Sugiura discloses the toner of claim 1 as discussed above, but fails to teach the size of the wax additives. Nakamura discloses a liquid toner (column 2, line 16) which comprises a polyethylene wax (column 2, lines 48-51), wherein the polyethylene wax

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has an average particle diameter of 3 to 50  $\mu\text{m}$ , preferable 3 to 10  $\mu\text{m}$  (column 9, lines 54-55). It would have been obvious to one of ordinary skill in the art at the time of the invention to use a polyethylene wax having a particle diameter of 3-10  $\mu\text{m}$  as disclosed in Nakamura for the toner of Sugiura because it is a known, usable, particle size for a polyethylene wax in a liquid toner.

### ***Response to Arguments***

8. Applicant's arguments filed 05/03/2010 have been fully considered but they are not persuasive. Applicant argues that Sugiura discloses a mixture of a resin and an additive dispersion, which are then mixed to form the toner, and therefore does not anticipate the additive dispersion as required by the instant claims. The examiner does not understand the argument. The instant specification shows that the dispersion is formed by mixing. Applicant has not shown how a mixture of a vinyl resin dispersion and a wax/colorant/binder dispersion would not result in the wax being dispersed in the resin.

### ***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rachel L. Burney whose telephone number is (571)272-9802. The examiner can normally be reached on Mon-Thurs: 7:30-6:00 PM, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 571-272-1385. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mark F. Huff/  
Supervisory Patent Examiner, Art Unit 1795

RLB